

R E M A R K S

Claims 1 to 9, 11 to 24 and 29 are in the case.

With this amendment, Applicant has amended Claims 1, 3 and 4 to correct grammatical errors and to more clearly point out the essence of the present invention.

The present invention provides an assembly for transferring a fluid between a vessel and a vial having a penetrable seal. Preferably, the vessel is a syringe carrying a liquid for diluting or dissolving or placing in suspension a medicant contained in the vial. Once the two components have been suitably mixed, the mixture is then transferred back to the syringe ready for injection.

The rejection of Claims 1 to 3, 9, 11 to 13 and 21 under 35 U.S.C. 102 as allegedly anticipated by Haber et al is respectfully traversed. Haber et al discloses a device which is used to transfer the liquid contents from a glass ampoule to a vial. The device of Haber et al teaches that there is a transfer apparatus wherein the neck of the ampoule may be broken and the liquid transferred to the vial. Subsequent to this, a separate syringe is utilized for penetrating the septum of the vial for subsequent injection. Clearly this is a substantially different arrangement than that of Applicant.

With respect to Claim 1, the Examiner has advanced the position that Haber discloses a slidable piston. The Examiner further states that the slidable piston is removably connected to the housing. In reality, the so-called slidable piston is a vial cup.

A review of Claim 1 will clearly show that Applicant calls for a slidable piston positioned within the body of the vessel — i.e. a syringe, which is clearly different from the interpretation taken by the Examiner wherein vial cup 92 is, as the name implies,

attached to the vial socket assembly. It is not seen how the interpretation given by the Examiner can remotely begin to read on Claim 1.

Applicant also calls for a second end of the conduit to be releasably connected to the vial socket assembly. This permits the disengagement of the housing from the vial socket assembly to permit use of the syringe for injection purposes.

In view of the above, it is believed that Claim 1 clearly and patentably defines over Haber et al. Similarly, Claims 2, 3, 9, 11 to 13 and 21 are also believed to be patentable for the reasons set forth above with respect to Claim 1.

Claims 1 to 4 and 21 were rejected under 35 U.S.C. 102 as allegedly being anticipated by Fowles et al. Again, reconsideration of this rejection is requested based on the following discussion.

Initially, the Examiner has stated that Fowles discloses an assembly for transferring fluid between a vessel and a vial comprising a housing with first (62) and second (72) ends and a bore (31, 62) extending therethrough and a slidable piston (55) removably connected to the housing.

Again, the Examiner has interpreted the teachings of Fowles et al in a manner which is not consistent with the wording of Claim 1. Thus, while there is a slidable member 55 which is connected to the housing, it is again drawn to the Examiner's attention that Claim 1 calls for a slidable piston positioned within the body of the vessel. This is clearly not the arrangement of Fowles et al. Similarly, Fowles et al does not show an arrangement wherein a second end of the conduit is releasably connected to the vial socket assembly such that the same may be removed and wherein the remaining components function as a

conventional syringe to be utilized for injection of the mixed components.

Accordingly, Claim 1 is believed to clearly and patentably define over Fowles et al.

Claims 2, 3 and 21 are likewise believed to be allowable for the reasons advanced regarding the allowability of Claim 1.

In the Office Action, Claims 5, 6 and 14 were rejected as allegedly being unpatentable over Fowles in view of Safabash.

Safabash discloses a transfer device that transfers medication from a vial to a reservoir. Again, this is completely different from what Applicant proposes. The object of Safabash is to transfer the medicant which has already been mixed to a syringe or the like. The teachings of Safabash cannot make up for the basic deficiencies of the primary reference. Thus there is nothing within the four corners of this patent which would enable one to function in the manner defined by Applicant. Accordingly, it is believed that Claims 5, 6 and 14 are patentable for the reasons set forth above.

Claims 7 and 8 were rejected as allegedly being unpatentable over Fowles in view of Safabash and further in view of Haining. In this regard, Haining is utilized to show that the use of spring members are well known. Applicant will not dispute that spring members are well known; however, the spring members in Haining are not located and do not function in a manner similar to that of the spring member of the present invention. Accordingly, Claims 7 and 8 are patentable for the reasons set forth above.

The rejection of Claim 10 as allegedly being unpatentable over Haber is respectfully traversed. Applicant has pointed out above the deficiencies of Haber and accordingly, Claim 10 is believed to be allowable.

Claims 15 to 24 were rejected as allegedly being unpatentable over Fowles in view of Safabash and further in view of Koller.

For the reasons discussed above, Claim 1 is believed to clearly and patentably define over the prior art and Claims 15 to 24 are dependent from Claim 1. Koller does not add anything to the teachings of Fowles and Safabash with respect from the basic deficiency of the primary reference. Furthermore, although Koller does show a piston backstop, it is not believed to respond to the limitations of Applicant's piston backstop.

It has been established in the jurisprudence that the Examiner may not resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. It is believed that the following jurisprudence is pertinent to the issues under consideration herein. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

It is respectfully submitted that the evidence adduced by the Examiner is insufficient to establish a prima facie case of obviousness. See In re Rijckaert, 9F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.

1988). Rejections based on 35 U.S.C. 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art.

As set forth above, it is Applicant's position that none of the references, either singularly or in combination, disclose the claimed combination set forth in Claim 1. Furthermore, the rejections of the other Claims under 35 U.S.C. 103 are traversed on the grounds that the selection of various elements from the prior art do not support a rejection under 35 U.S.C. 103 since there is nothing within the four corners of these references which would lead one to the present invention save and except for Applicant's own disclosure thereof.

New Claim 29 includes all the essential limitations of Claim 1 and for this reason is also believed to be allowable.

It is now believed that this application is in order for allowance, and such action is respectfully solicited.

Respectfully,



Eric Fincham

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Eric Fincham

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